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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,454	08/24/2001	Carol J. Collins	NEU-40	2232

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EXAMINER

SHEIKH, HUMERA N

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,454

Applicant(s)

COLLINS ET AL.

Examiner

Humera N. Sheikh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

Receipt of the Remarks/ Arguments and request for extension of time (1 month-granted), both filed 12/22/03 is acknowledged.

Claims 1-24 are pending. Claims 1-24 remain rejected.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shukuzaki *et al.* (US Pat. No. 5, 266,321) in view of Sunkel *et al.* (US Pat. No. 6,542,598 B2).

Shukuzaki teach an oily make-up cosmetic comprising a silicone gel composition, which comprises a partially crosslinked organopolysiloxane polymeric compound and a low viscosity silicone oil (see reference column 2); (col.7); (col.8, lines 47-56); and examples. Specific examples of the low viscosity oils are: dimethylpolysiloxane, methylphenylpolysiloxane, octamethylcyclotetrasiloxane, decamethylcyclopentasiloxane and the like (col. 7, lines 3-16). Various cosmetic powders, such as mica can be included in the composition (col. 7, lines 32-45). The make-up cosmetic can be applied

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to a foundation, eye shadow, face powder, lip stick and the like and can take various forms including a solid, stick and the like (col. 8, lines 53-56).

Shukuzaki is deficient only in the sense that he does not explicitly teach the make-up cosmetic in the form of mascara.

Sunkel teach cosmetic compositions comprising siloxane elastomers wherein the composition may be in the form of a foundation, *mascara*, eye shadows, powders, blushers, lip color and the like (see reference column 2, lines 35-55); Example II and claims 1, 13 and 20.

Therefore, it would have been obvious to one of ordinary skill in the pharmaceutical art at the time the invention was made to use the teachings of Sunkel within the teachings of Shukuzaki because Sunkel explicitly teaches cosmetic compositions comprising organopolysiloxane elastomers wherein the cosmetic composition may be in various forms, such as foundation, *mascara*, eye shadows, powders, lip color, blushers and the like and similarly, Shukuzaki teaches the use of polyorganosiloxane elastomers in a make-up cosmetic wherein the composition can be applied to foundations, eye shadows, face powder, lip stick and the like and can take various forms including a solid, stick. The expected result would be an improved, cosmetic composition, such as in the form of mascara, that provides softening, moisturizing and conditioning properties.

Prior Art made of record and deemed relevant by the Examiner:

US Pat. No. 5, 412,004 Tachibana *et al.* 02/1994

Response to Arguments

The applicant's arguments filed 12/22/03 have been fully considered, but were not found to be persuasive.

Firstly, the Applicant argues, "Shukuzaki is silent with respect to mascara, which is applied to the eyelashes and eyebrows. Rather, Shukuzaki relates to cosmetics that are applied to the skin. Shukuzaki actually teaches away from mascaras, which require stickiness in order to help the compositions adhere to the hairs."

These arguments have been fully considered, but are not found to be persuasive. Shukuzaki teaches an oily make-up cosmetic comprising a silicone gel composition, which comprises a partially crosslinked organopolysiloxane polymeric compound and a low viscosity silicone oil (see column 2); (col.7); (col.8, lines 47-56); and examples. The make-up cosmetic can be applied to a foundation, eye shadow, face powder, lip stick and the like and can take various forms including a solid, stick and the like (col. 8, lines 53-56). Although Shukuzaki does teach that the composition can be applied in various forms (i.e., foundation, eye shadow, powders), Shukuzaki is lacking only in the sense that he does not explicitly teach the composition in the form of mascara. The secondary reference of Sunkel resolves this only deficiency of Shukuzaki and was relied upon for the generic teaching of polysiloxane elastomers in a mascara formulation. Sunkel also explicitly teaches that the cosmetic composition may be in the form of foundations, eye shadows, powders, lip colors and the like (as also taught by Shukuzaki) and can provide

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improved skin-feel properties (see col. 1, line 59 through col. 2, line 55). Therefore the incorporation of polysiloxane elastomers in various forms of cosmetics (i.e., foundation, eye shadows, powders and mascaras), are deemed to be functionally equivalent.

Secondly, the Applicant argues, "While Sunkel et al. does disclose the use of silicone elastomers in mascara, Sunkel et al. does not disclose, nor suggest, a mascara that comprises less than about 1%, by weight of wax, as set forth in independent claim 1 of the present application. The mascara of Sunkel comprises 3% carnauba wax, 3.75% white beeswax, 2.25% paraffin wax 118/125, and 2.25% paraffin wax."

The Applicants' arguments have been fully considered, but are not found to be persuasive. The teachings of Sunkel have been delineated above. Sunkel teaches the use of siloxane elastomers in mascara formulations (see col. 2, lines 35-55, example II and claims). The applicants argument that Sunkel does not teach less than about 1% by weight of wax is not persuasive, since, generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). The use of wax in amounts greater than about 1% would not be considered detrimental to the formulation itself since Sunkel explicitly teaches a mascara formulation which provides benefits of improved feel, such as softening, moisturization and conditioning. Furthermore, one of ordinary skill in the art would be able to determine suitable amounts of wax through routine or manipulative experimentation to obtain the best possible results. Moreover,

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the instant claims do not recite a mascara that is 'wax-free'. There is no critical difference observed between a mascara having about 1% wax or one having 3% wax in the formulation. The instant recitation of "less than about 1% by weight of wax" includes for example .999% by weight of wax. The applicants have not shown that the small amount of differences in wax percentages between the prior art and the instant claims are a crucial difference. Sunkel utilizes similar ingredients for a similar cosmetic product (mascara) for a similar intended purpose as the Applicants.

Lastly, the Applicants argues, "Applicants have attached Exhibit A assigned to Revlon Consumer Products Corporation, a major marketer of mascaras. A gold standard mascara should provide optimal length, color, thickness, and curl to the lashes.....However waxes provide undesirable properties....waxes cause mascaras to increase in viscosity during storage.....mascaras have reduced shelf life. It is also interesting to note that despite the realization of the above-referenced drawbacks of the use of waxes, Examples 1 and 3 of the '519 patent still contain 2% and 1.8% by weight respectively of rice wax, about twice the upper limit recited by claim 1 of the present invention."

These arguments have been thoroughly considered but are not found to be persuasive. As the Applicant denotes, 'the '519 patent contains 2% and 1.8% of rice wax'. The wax provides properties such as optimal length, color, thickness, etc. to the lashes. Therefore, it is the position of the Examiner that since the prior art (WO 00/74519) teaches the use of wax (2.0 & 1.8%), which is greater than the 'less than about 1% by weight of wax' as instantly claimed, the particular amounts incorporated by the prior art would not be considered to be detrimental to the mascara formulation itself, but rather would be deemed suitable and effective amounts of wax that would not

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contribute to any major undesirable drawbacks. Moreover, one skilled in this art would be capable of determining suitable amounts through the use of routine experimentation. The prior art teaches a formulation comprising similar ingredients used in the same field of endeavor to provide for similar properties. Hence, the instant invention is rendered obvious and unpatentable over the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday through Friday from 7:00A.M. to 4:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

hns *A.N.S.*

March 18, 2004



Gollamudi S. Kishore, PhD
Primary Examiner
Group 1600